Application Number: 09/783,660   Docket: SPROQD1100 (34815/US)
Reply to Final O.A. of January 31, 2006,
Advisory Action of April 13, 2006, and
Advisory Action of May 23, 2006

REMARKS/ARGUMENTS

Claims 1, 3-53, 55-59, and 61-70 are pending in this application and are rejected under either 35 U.S.C. § 102 or 35 U.S.C. § 103. Claims 1, 38, 53, and 59 are presently amended and claims 2, 54, and 60 are canceled. For at least the reasons set forth below, Applicants assert that all claims are in condition for allowance.

Rejection under 35 U.S.C. § 102

Claims 1, 3-18, 38-44, 53, 55-59, 61-65, 67, 69, and 70 were rejected under 35 U.S.C. § 102(b) as being anticipated by Filepp et al U.S. 5,347,632. Independent claims 1, 38, 53, and 59 have been amended to recite defining or generating a user interface form based upon or being dictated by a number of device capabilities for a client device. Examiner agrees that *Filepp* fails to teach these limitations (see, OA dated 1/31/2006, page 13, "Filepp...does not say a UI formatting module that generates said UI form definition based upon a number of device capabilities for a client device that includes said client device architecture."). Accordingly, Filepp fails to describe every element of every claim *"in as complete detail"* as is contained in the claims, as required by MPEP § 2131. However, the § 103 rejection asserts that Kikinis teaches this limitation, and therefore, the limitation is addressed below with respect to the 35 U.S.C. § 103 rejection.

Therefore, the 35 U.S.C. § 102 rejection of these claims as amended is unsupported by the art. For at least the reasons stated below, Applicants respectfully request that the rejection be withdrawn.

Rejection under 35 U.S.C. § 103

Claims 2, 19-37, 45-52, 54, 60, 66, and 68 were rejected under 35 U.S.C.§ 103(a) as being unpatentable over *Filepp* in view of *Kikinis* U.S. 5,727,159.

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The *Filepp* and *Kikinis* references are not properly combinable because the *Filepp* reference teaches away from being modified or combined with other references to achieve the present claimed invention:

> A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

In re Gurley, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (Fed.Cir.1994). The Court also noted that there is "no suggestion to combine" references where one reference deliberately seeks to avoid a teaching of the other reference. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed.Cir.1988). When deliberating on prior art, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02 (VI).

In the present application, whereas *Filepp* is directed towards an architecture that reduces the load on the server and provides for a fat client (i.e., client that performs the bulk of the data processing operations), *Kikinis* and the present invention are directed towards an architecture that reduces the load on the client and provides for a thin client (i.e., server that performs the bulk of the data processing operations, *see* Col. 2, lines 26-36; Col 6, lines 6-36). Accordingly, considering each reference "in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention," one skilled in the art would not reasonably combine *Filepp* with *Kikinis*, or any other reference, to teach or suggest the limitations of the present claimed invention. MPEP § 2141.02 (VI).

The present invention is directed towards a thin client architecture, where substantial proportions of the processing are performed server-side to reduce the load on the client. *See* claims 1, 17, 32, 36, and 45; *see, also*, Spec. p. 6, lines 19-21 ("A preferred embodiment of the present invention provides a data communication architecture that exhibits the following attributes: a relatively thin client for reduced client-side resource demands...") (emphasis added) In stark contrast, *Filepp* is directed towards an architecture that reduces the load on the server and provides for a fat client:

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> ...the invention includes procedures for formulating objects that
> have been specially structured to include display data, <u>control data
> and program instructions</u> for supporting the applications at the
> network reception systems, the objects being pre-created, parceled
> units of information that may be <u>distributed and stored at lower
> levels in the network</u>...<u>so as to reduce processing demand on the
> network higher element</u>...

Col. 2, line 60-Col. 3, line 1 (emphasis added); *see, also* Col. 76, lines 37-47 ("the table can be

presented to the user's RS 400, where the [client-side] RS 400 can provide the data processing

required to present the potentially relevant keywords, objects and associated applications to the

user...<u>this procedure reduces demand on server</u>..."); *see, also* Col. 1, lines 16-25 ("This

invention relates generally to a distributed processing...computer network in which the

interactive text/graphic sessions are comprised of pre-created blocks of data and <u>program

instructions which may be distributed downwardly in the network</u> for use at a software enhanced

user computer terminal that <u>reduces processing demand on the higher-level network

elements</u>..."); *see, also* Col. 75, lines 41-56 ("the method aspect of the invention includes an

improved procedure for searching and retrieving applications from the store of applications

distributed throughout network...<u>this reduces the demand on the server</u>...").

Accordingly, *Filepp* teaches away from being modified or combined with *any* other

references to achieve the present claimed invention. One of ordinary skill in the art would not be

motivated to combine the *Filepp* (fat client) reference with *Kikinis* (thin client) to achieve the

present claimed invention because the data processing allocation of each these references are

incompatible. Considering the *Filepp* reference "in its entirety, i.e., as a whole, <u>including

portions that would lead away from the claimed invention</u>," one skilled in the art would not

reasonably combine *Filepp* and *Kikinis*.

Declaration of Prior Invention Under 37 CFR § 1.131

Included with Applicant's Amendment and Response dated November 17, 2005, was a

37 CFR § 1.131 declaration swearing back of the *Patrick* reference and effectively antedating the

reference in accordance with MPEP § 715. Examiner asserted that the declaration was

ineffective to overcome the *Patrick* reference because "diligence is lacking from October 23,

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2000 to at least the publication date of the Patrick reference dated 1/30/2001." Applicants respectfully disagree, and it is unclear to Applicants why documentation disclosed with the declaration and dated after 10/23/2000 and before 1/30/2001 did not demonstrate due diligence between those dates. However, because the rejection relying on the *Patrick* reference was withdrawn and no longer forms part of the current rejection, Applicants believe this issue does not require disposition at this time.

Double Patenting Rejection

Claims 1-3, 5-6, 10-18, 46-47, 19-20, 29-31, 33-34, 36, 38, and 45 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent Application No. 09/783,673 in view of Simonoff et al., U.S. Pat. No. 6,078,322. A terminal disclaimer was filed with Applicants' Amendment and Response dated November 17, 2005, but Examiner indicated that the terminal disclaimer was not accepted.

Applicants are currently working to obtain a new terminal disclaimer signed by an authorized person and fully expect to obtain such terminal disclaimer to overcome the nonstatutory double patenting rejection, thereby obviating this rejection. In the meantime, Applicants respectfully request that this rejection be held in abeyance.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

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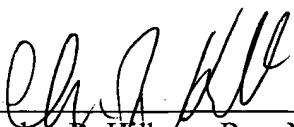
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